II. Rejection of Claims 1-31 under 35 U.S.C. § 103(a)

Claims 1-31 are pending in the instant application. Claims 1-31 stand rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Beams et al. (WO 93/13055). For the following reasons, this rejection is respectfully traversed.

Beams et al. does not exemplify the compounds of the present invention. Applicants concede that Beams et al. discloses the compounds (±) –E-2-Amino-6-(1-Iminoethylamino)-hex-4-enoic acid hydrochloride (page 13, lines 24-31) and (±) –Z-2-Amino-6-(1-Iminoethylamino)-hex-4-enoic acid hydrochloride (page 15, lines 1-10). These compounds are hexenoic acid derivatives, however, and are not the heptenoic acid derivatives of the present invention. In a biological system, the addition of a methylene group to a compound may have profound effects upon the activity of the compound. For example, ethyl alcohol is commonly used in beverages. Isopropyl alcohol, however, is known to be toxic. Isopropyl alcohol is one methylene greater than ethyl alcohol. Likewise, one skilled in the art would not be able to predict that the 2-amino-4,5 heptenoic acid derivatives of the present invention would be similar in biological activity to the hexenoic acid derivative exemplified in Beams et al.

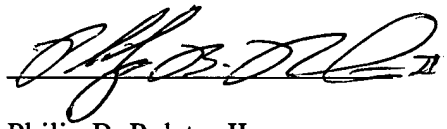
Thus, the instantly claimed compounds are not obvious in view of the Beams reference. See MPEP 2144.08; *In re Jones*, 958 F.2d 347, 350, 21 USPQ2d 1941, 1943 (Fed. Cir. 1992) (Federal Circuit has "decline[d] to extract from *Merck* [*& Co. v. Biocraft Laboratories Inc.*, 874 F.2d 804, 10 USPQ2d 1843 (Fed. Cir. 1989)] the rule that... regardless of how broad, a disclosure of a chemical genus renders obvious any species that happens to fall within it."); *In re Grabiak,* 769 F.2d 729, 731, 226 U.S.P.Q. 870, 872 (Fed. Cir. 1985) ("[G]eneralization is to be avoided insofar as specific structures are alleged to be *prima facie* obvious one from the other."); *In re Baird* 29 U.S.P.Q.2D (BNA) 1550, 1552 (Fed. Cir. 1994) (The fact that a claimed species or subgenus is encompassed by a prior art genus is not sufficient by itself to establish a *prima facie* case of obviousness).

Conclusion

In view of the above, it is submitted that Claims 1-31 are in condition for allowance. Reconsideration of the rejections and objections is requested, and allowance of Claims 1-31 at an early date is solicited.

If the Examiner believes a telephonic interview with Applicant's representative would aid in the prosecution of this application, he is cordially invited to contact Applicant's representative at the below listed number.

Respectfully submitted,



Philip B. Polster II
Reg. No. 43,864
(314) 274-9094
(314) 274-9095 (facsimile)

Pharmacia Corporation
Corporate Patent Department
P.O. Box 1027
Chesterfield, Missouri 63006